

REMARKS

Claims 1, 9, 12-16, 18-27, and 40-42 have been examined. Claims 33-39 have been canceled, without prejudice, for filing in a divisional application. Claim 25 has been amended. New claim 43 has been added. Reconsideration of the application, as amended, is respectfully requested.

Interview

Counsel wishes to thank the Examiner for the interview of November 30, 2005 where the cited art was discussed as summarized below.

Information Disclosure Statement

The IDS which was filed after the final Office Action on November 22, 2005 is being resubmitted herewith along with additional references which have come to the attention of the Applicant.

Election/Restrictions

Claims 33-39 have been canceled, without prejudice, for filing in a divisional application.

Claim Rejections Under 35 U.S.C. § 103(a)

Rejection Over Aguerre, Seidel, Admitted Prior Art and Albiniano

Claims 1, 9, 12-16, 18-27 and 40-42 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over the cited portions of U.S. Patent No. 6,237,249 to Aguerre, *et al.* (hereinafter "Aguerre") in view of U.S. Patent No. 4,476,600 to Seidel, *et al.* (hereinafter "Seidel"), the alleged admitted prior art page 11 of the instant specification and U.S. Patent No.

2,897,566 to Albiniano (hereinafter "Albiniano"). This rejection is respectfully traversed for at least the reasons which follow.

The presently pending claims relate to footwear comprising a base section and a strap section, both respectively formed as a part molded from lofted foam material. The strap section is attached to the base section such that the strap pivots relative to the base section with a frictional force at the contact between the inner portion of the strap section and the outer portion of the rear sole perimeter to thereby maintain the strap section fixed relative to the base section.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The teaching or suggestion to make the claimed combination must be found in the prior art, and not be based on applicants' disclosure. See M.P.E.P. §§2143.01 and 2143.03.

The present rejection fails to present a *prima facie* case of obviousness for at least two reasons. First, as mentioned above, the present claims require that the strap section is formed as a second continuous piece of a lofted foam material. None of the cited art teaches this limitation. More specifically, Seidel fails to teach any strap and neither Aguerre nor Albiniano teach or suggest a strap that is made out of such a material. Further, counsel forcefully disagrees that the present application admits that making such a strap of a lofted foam material is prior art. Although the application does describe an existing type of lofted foam material that is useful in connection with the present invention, the specification never admits that this material was known in making a heel strap as claimed.

Because the cited art fails to teach or suggest an important limitation of the rejected claims, claims 1, 9, 12-16, 18-27 and 40-42 are distinguishable without amendment.

Moreover, the claims of the present invention also require a frictional force at the contact between the inner portion of the strap section and the outer portion of the rear sole perimeter which maintains the strap section fixed relative to the base section. The amount of

friction generated is dictated in part because the two materials which contact each other (from the shoe body and the strap) are both constructed of a lofted foam. This allows the strap to remain in a secure location while also being relatively easy to pivot when desired.

Contrary to the present claims, Aguerre discloses a "slide-type sandal, having an elastic and flexible rear heel strap 102." Col. 4, lines 28-29. The rear heel strap disclosed by Aguerre is further described as being capable of being "freely rotated" between a first and second position. *See, e.g.*, Col. 7, lines 49-53; Col. 9, lines 29-34, and Col. 10, lines 48-50. In fact, in several embodiments, additional washers are added to ensure free rotation about the rotation point. As explained in Aguerre, "during rotation of the rear heel strap 202 about the rivet 244, it is common for the friction between the heel strap 202, the vamp 204 and the rivet 244 to interfere with smooth rotation. In order to facilitate smoother rotation of the rear heel strap 202 about the rivet 244, one of a first pair of nylon washer separators 246 is placed on the inside of the rear heel strap 202 and one of a second pair of nylon washer separators 248 is placed on the outside of the rear heel strap 202 as shown in FIG. 12." Col 9, lines 20-29.

As such, it is submitted that Aguerre fails to teach a molded, lofted foam heel strap configured such that a frictional force at the contact between the inner portion of the strap section and the outer portion of the rear sole perimeter maintains the strap section fixed relative to the base section.

While the office action attempts to cure this remedy by citing the Albiniano patent, it is well established law that the teachings of one reference may not be combined with the teaching of a second reference when there is a specific teaching away. As previously described, Aguerre specifically teaches the benefits of being freely rotated and uses washers to accomplish this. Hence, one of skill in the art would have no motivation to substitute it washers for the connectors described in Albiniano. Rather, such a combination is clearly hindsight reconstruction of the cited art, which is clearly impermissible.

Because the heel strap of Aguerre is designed to freely rotate about its connection point, and to specifically minimize friction to ensure free rotation through use of, *e.g.*, washer separators, it may not be properly combined with Albiniano.

In addition, with reference to Claim 42 and certain of the dependent claims, Aguerre fails to specifically disclose that the distance from the first attachment point to the second attachment point along the upper opening perimeter is approximately the same distance from the first attachment point to the second attachment point along the strap section, or that the distance from the first attachment point to the second attachment point along the rear sole perimeter is approximately the same distance from the first attachment point to the second attachment point along the strap section. Further, Aguerre fails to specifically disclose that the strap section can pivot relative to the base section such that an inner portion of the strap section contacts an outer portion of the rear sole perimeter.

Hence, for this additional reason, a *prima facie* case of obviousness has not been established. Therefore, Applicants traverse the rejection of claims 1, 9, 12-16, 18-27, and 40-42, and respectfully request withdrawal of this rejection.

Rejection Over Aguerre, Seidel, Admitted Prior Art and Albiniano and Lamstein

Claims 24 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Aguerre, Seidel, Admitted Prior Art, Albiniano the cited portions of U.S. Patent No. Des 416,667 to Lamstein, *et al.* (hereinafter "Lamstein").

Whatever else Lamstein may disclose, it does not disclose a heel strap constructed of a lofted foam material that is configured such that a frictional force at the contact between the inner portion of the strap section and the outer portion of the rear sole perimeter maintains the strap section fixed relative to the base section. As such, for at the least these reasons and those detailed above, this rejection is traversed and withdrawal of this rejection is respectfully requested.

Appl. No. 10/602,416
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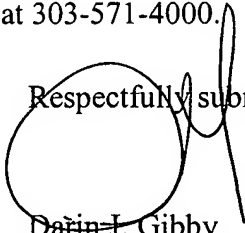
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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,


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